REMARKS

In response to the above-identified Final Office Action ("Action"), Applicants traverse the Examiner's rejection to the claims and seek reconsideration thereof. Claims 1, 5 and 8-35 are now pending in the present application. Claims 1, 8 and 10-28 remain withdrawn. Claims 5, 9 and 29-35 are rejected. In the instant response, no claims are amended, no claims are added and no claims are cancelled.

I. Examiner Interview Summary

Applicants acknowledge with appreciation the Examiner's willingness to conduct an interview with Applicants' representative by telephone on January 14, 2008. During the interview the rejections of claim 5 based on Japanese Application No. JP 1998-288495 issued to Hiroichi et al. ("Hiroichi") were discussed. In particular, Applicants' representative pointed out that claim 5 recites that the additive is "1.0 to 10 wt%" not .01% as noted by the Examiner and Hiroichi discloses an active mass containing ≤ 0.5, not 5% as alleged by the Examiner. Upon review of the case, the Examiner recognized the errors noted by Applicants' representative and indicated a corrected Office Action in response to the instant Response to Office Action would be issued.

II. Claims Rejected Under 35 U.S.C. § 103

A. In the outstanding Action, claims 5, 29, 30, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,851,696 issued to Saidi et al. ("Saidi") in view of Hiroichi. Applicants respectfully traverse the rejections as follows.

To establish a *prima facie* case of obviousness, the Examiner must set forth "some articulated reasoning with some rational underpinning to support the conclusion of obviousness." See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103*, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

In regard to independent claim 5, Applicants respectfully submit Saidi and Hiroichi fail to disclose or render predictable at least the elements of "wherein the amount of the additive is 1.0 to 10 wt% of the positive active material" as recited in claim 5.

The Examiner alleges that Saidi discloses the majority of the elements of claim 5, however, states Saidi "is silent to an electrode additive of at least one of Si, Ga, Ge, Ca, Sr and Ba, in an amount of 0.01 to 10wt%." See Action, page 4. The Examiner instead alleges Hiroichi discloses the use of "silicon in lithium oxide electrode materials in the amount of 5%" in the Abstract therefore this element would be obvious. See Action, page 4.

Applicants' respectfully disagree with the Examiner's characterization of claim 5 and Hiroichi. In particular, claim 5 recites that "the additive is **1.0** to 10 wt% of the positive active material" (emphasis added), not 0.01 as stated by the Examiner. Moreover, the Abstract of Hiroichi discloses that the cathode active mass may contain "Si$\leq$0.5" not silicon in the amount of 5% as stated by the Examiner. Thus, for at least the foregoing reasons, the Examiner has not established that the combination of Saidi and Hiroichi discloses or renders predictable each and every element of claim 5. Since each of the elements of claim 5 are not found within the prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103 over Saidi and Hiroichi.

In regard to claims 29, 30, 33 and 34, these claims depend from claim 5 and incorporate the limitations thereof. Thus, for at least the reasons that claim 5 is not *prima facie* obvious over Saidi and Hiroichi, claims 29, 30, 33 and 34 are further not obvious over the prior art. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 29, 30, 33 and 34 under 35 U.S.C. §103 over Saidi and Hiroichi.

B. In the outstanding Action, claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Saidi in view of Hiroichi and further in view of U.S. Patent Publication No. 2001/0010807 issued to Matsubara ("Matsubara"). Applicants respectfully traverse the rejections as follows.

Claim 35 depends from claim 5 and incorporates the limitations thereof. For at least the reasons previously discussed, Hiroichi and Saidi fail to disclose or render predictable at least the element of "wherein the amount of the additive is 1.0 to 10 wt% of the positive active material." The Examiner has not pointed to, and Applicants are unable to discern, a portion of Matsubara curing the deficiencies of Saidi and Hiroichi with respect to at least the element. Since each of the elements of claim 35 are not found within the prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 35 under 35 U.S.C. §103 over Saidi, Hiroichi and Matsubara.

C. In the outstanding Action, claims 5, 9 and 29-32 rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,589,694 issued to Gosho et al. ("Gosho") and further in view of and further in view of Hiroichi. Applicants respectfully traverse the rejections as follows.

In regard to independent claim 5, Applicants respectfully submit for at least the reasons previously discussed, Hiroichi fails to disclose or render predictable at least the elements of "wherein the amount of the additive is 1.0 to 10 wt% of the positive active material" as recited in claim 5. The Examiner further admits that Gosho fails to disclose or render predictable this element. Since each of the elements of claim 5 are not found within the prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103 over Gosho and Hiroichi.

In regard to claims 9 and 29-32, these claims depend from claim 5 and incorporate the limitations thereof. Thus, for at least the reasons that claim 5 is not *prima facie* obvious over Gosho and Hiroichi, claims 9 and 29-32 are further not obvious over the prior art. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 9 and 29-32 under 35 U.S.C. §103 over Gosho and Hiroichi.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on February 13, 2008.

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